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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,701	08/31/2001	Jun Kawaguchi	M 6712 HST/NI PCT/US	1007

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EXAMINER
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ZHENG, LOIS L

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/914,701

Applicant(s)

KAWAGUCHI ET AL.

Examiner

Lois Zheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-11,13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-11, 13 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Claim Status***

1. Claims 13, 15-16, 19 and 22-23 are amended in view of the amendment filed on 17 February 2005.

Claims 12 and 14 are cancelled.

New claims 24-25 are added in view of the amendment.

Therefore, claims 1, 6-11, 13 and 15-25 remain under examination.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6-10, 13, 15-17, 19-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/09006(WO'006).

The teachings of WO'006 are discussed in paragraph 5 of the previous Non-Final Office Action. The rejection ground is maintained for the same reason as stated in the previous Office Action.

With respect to the new claims 24-25, since claims 24-25 recite the same composition as claimed in claim 1, the same rejection ground applies for the same reason as stated in the rejection of independent claim 1 in paragraph 5 of the previous Non-Final Office Action.

4. Claims 11, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO'006 in view of Yamamoto et al US 4,517,030(Yamamoto) and Bitter et al US 5,152,849(Bittner).

The teachings of WO'006 are discussed in paragraph 5 of the previous Non-Final Office Action. The teachings of Yamamoto and Bittner are discussed in paragraph 6 of the previous Office Action. The rejection ground is maintained for the same reason as stated paragraph 6 of the previous Office Action.

5. Claims 1, 6, 8, 16, 19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda US 5,645,706(Matsuda).

The teachings of Matsuda are discussed in paragraph 7 of the previous Non-Final Office Action. The rejection ground is maintained for the same reason as stated in the previous Office Action.

With respect to the new claims 24-25, since claims 24-25 recite the same composition as claimed in claim 1, the same rejection ground applies for the same reason as stated in the rejection of independent claim 1 in paragraph 7 of the previous Non-Final Office Action.

6. Claims 11, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda in view of Yamamoto and Bittner.

The teachings of Matsuda are discussed in paragraph 7 of the previous Non-Final Office Action. The teachings of Yamamoto and Bittner are discussed in paragraphs 6 and 8 of the previous Office Action. The rejection ground is maintained for the same reason as stated paragraph 8 of the previous Office Action.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 6-11, 13 and 15-25 have been considered but are not persuasive.

In the remarks, applicant argues that "While it is possible that there are theoretical numbers within the ranges disclosed by the Bjerrum(i.e. WO'006) that might satisfy the Applicant's claimed equations, that does not render the present claims obvious because there are also many theoretical numbers within the ranges that would not satisfy the Applicant's claimed equations." Applicant further argues that "the Bjerrum references fails to exemplify any compositions which satisfy those equations";

Applicant is reminded that examples in WO'006 and Matsuda references are merely embodiments of their inventions, therefore, do not cover the entire scope of their inventions. The rejection grounds are based on the broadest concentration ranges disclosed by WO'006 or Matsuda, both of which encompass the claimed concentration ranges. Therefore, prima facie cases of obviousness have been properly established based on the WO'006 reference or by the Matsuda reference.

In addition, with respect to the claimed mathematical equations, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685,

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688. Even if patentable weight were to be given to the claimed equations, one of ordinary skill in the art would have also found that the concentrations disclosed by WO'006 or Matsuda satisfy the claimed equation since WO'006 or Matsuda teaches similar component concentration ranges.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLZ

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700